



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,993	07/11/2003	Robert Toth	TOTH-3	4242
52450	7590	06/15/2009	EXAMINER	
KRIEG DEVAULT LLP ONE INDIANA SQUARE SUITE 2800 INDIANAPOLIS, IN 46204-2079			PIERCE, WILLIAM M	
			ART UNIT	PAPER NUMBER
			3711	
			MAIL DATE	DELIVERY MODE
			06/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT TOTH

Appeal 2008-004543
Application 10/617,993
Technology Center 3700

Decided:¹ June 15, 2009

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*,
ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*, and
LINDA E. HORNER, ANTON W. FETTING, and JOHN A. JEFFERY,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Robert Toth (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-6. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is a method for a one game scratch match play, single elimination tournament. Spec. 1:5-7. Claim 1, reproduced below, is the sole independent claim and is representative of the subject matter on appeal.

1. A method for providing a one game scratch match play single elimination tournament for league players, comprising the steps of:
 - a. providing a pool of eligible league players;
 - b. placing each eligible league player into one of eight divisions, each division being defined by highest average scores attained by league players in current league play;
 - c. conducting a local first round of competition in which each of the eligible league players in each of the eight divisions engages in one game scratch match play, single elimination, eight-player brackets, until one player prevails in each division and continues on to a regional second round;

- d. conducting a regional second round in 512 locations that are geographically distributed as equally as possible in which each of the eight divisions engages in one game scratch match play, single elimination, until one player prevails in each division and continues on to a championship round; and
- e. conducting a championship round in a single location in which each of the 512 league players who prevail in the regional second round in each of the eight divisions engages in one game scratch match play, single elimination, until 8 tournament champions prevail, one in each of the eight divisions.

THE REJECTION

The Appellant seeks review of the Examiner's rejection of claims 1-6 under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ISSUE

The issue before us is whether the Appellant has shown that the Examiner erred in concluding that the claimed method for conducting a tournament for league players is drawn to patent-ineligible subject matter under 35 U.S.C. § 101.

PRINCIPLES OF LAW

The law in the area of patent-eligible subject matter for process claims has recently been clarified by the Federal Circuit in *In re Bilski*, 545 F.3d

943 (Fed. Cir. 2008) (en banc), *cert. granted*, 77 USLW 3442 (U.S. Jun. 1, 2009) (No. 08-964).

The en banc court in *Bilski* held that “the machine-or-transformation test, properly applied, is the governing test for determining patent eligibility of a process under § 101.” *Id.* at 956. The court in *Bilski* further held that “the ‘useful, concrete and tangible result’ inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]” *Id.* at 959-60.

The court explained the machine-or-transformation test as follows: “A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.” *Id.* at 954 (citations omitted). The court explained that “the use of a specific machine or transformation of an article must impose meaningful limits on the claim’s scope to impart patent-eligibility” and “the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.” *Id.* at 961-62 (citations omitted). As to the transformation branch of the inquiry, the court explained that transformation of a particular article into a different state or thing “must be central to the purpose of the claimed process.” *Id.*

ANALYSIS

The Appellant argues claims 1-6 as a single group. App. Br. 4-7. We select claim 1 as the representative claim, and claims 2-6 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that the claimed method results in no physical transformation of any materials or subject matter to a different state or thing, and there is no machine being claimed. Ans. 5-6. The Appellant argues that the claim is drawn to patent-eligible subject matter because the final result achieved, *viz.*, eight tournament champions prevailing after a one game scratch match play single elimination tournament for league players, is a useful, tangible and concrete result. App. Br. 7. The Appellant's argument is unavailing because it relies on insufficient considerations and it does not address the failure of the claim to meet the requirements of the machine-or-transformation test. *See Bilski*, 545 F.3d at 959-60 ("the 'useful, concrete and tangible result' inquiry is inadequate [to determine whether a claim is patent-eligible under § 101.]").

Method claim 1 fails to meet the requirements of the machine-or-transformation test for patent-eligible subject matter, because the claimed method is neither tied to a particular machine or apparatus, nor does it transform a particular article into a different state or thing.

Method claim 1 recites a series of steps for "providing a one game scratch match play single elimination tournament for league players." The claim does not invoke any particular machine or apparatus in the method steps and thus is not tied to any particular machine or apparatus. The wording of claim 1 is broad in that it refers generally to a tournament for "league players." The claim does not limit the play to any particular game and thus does not limit the method to implementation using any particular

machine or apparatus. As such, the claims fail the first prong of the machine-or-transformation test.

The steps of method claim 1 also fail the second prong of the machine-or-transformation test because the method does not transform any article to a different state or thing. The method steps entail providing a pool of players, organizing the players into divisions, and then conducting various rounds of competition. The claims are similar to the claims that were before the court in *Bilski* in that the pending claims call for performing method steps that involve transformations or manipulations of relationships.²

This type of manipulation of relationships between league players is the very type of abstraction that the court in *Bilski* found cannot meet the

² The method claim in *Bilski* called for:

A method for managing the consumption risk costs of a commodity sold by a commodity provider at a fixed price comprising the steps of:

(a) initiating a series of transactions between said commodity provider and consumers of said commodity wherein said consumers purchase said commodity at a fixed rate based upon historical averages, said fixed rate corresponding to a risk position of said consumer;

(b) identifying market participants for said commodity having a counter-risk position to said consumers; and

(c) initiating a series of transactions between said commodity provider and said market participants at a second fixed rate such that said series of market participant transactions balances the risk position of said series of consumer transactions initiating a series of transactions between said commodity provider and consumers of said commodity.

Appeal 2008-004543
Application 10/617,993

second prong of the machine-or-transformation test. 545 F.3d at 963 (“Purported transformations or manipulations simply of public or private legal obligations or relationships, business risks, or other such abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances.”).

The method as claimed does not involve the transformation of any physical object or substance, and given that the claim also is not tied to a particular machine or apparatus, the claim entirely fails the machine-or-transformation test and is not drawn to patent-eligible subject matter under 35 U.S.C. § 101.

CONCLUSION

The Appellant has failed to show the Examiner erred in concluding that the claimed method for conducting a tournament for league players is drawn to patent-ineligible subject matter under 35 U.S.C. § 101.

DECISION

The decision of the Examiner to reject claims 1-6 is AFFIRMED.

Appeal 2008-004543
Application 10/617,993

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

vsh

KRIEG DEVAULT LLP
ONE INDIANA SQUARE
SUITE 2800
INDIANAPOLIS IN 46204-2079